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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,089	02/28/2002	Scott P. Schreer	3247NJJ (058201-00050)	3357
26304 7590 12/27/2007 KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585			EXAMINER SALCE, JASON P	
			ART UNIT 2623	PAPER NUMBER
			MAIL DATE 12/27/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/086,089	Applicant(s) SCHREER, SCOTT P.	
	Examiner Jason P. Salce	Art Unit 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 7/17/2007 have been fully considered but they are not persuasive.

Applicant states that the location in the network of where the monitoring functionality is taking place is not significant and the significance is that the monitoring takes place after it receives the broadcast. The examiner disagrees and notes that Applicant has continually argued that the monitoring is not taking place at the user's location and that a monitoring station performs the monitoring of the broadcast before transmission to a plurality of users. The examiner notes that this is significant, because as the claims are currently written, monitoring could be performed at the user's location, an intermediate location in the network, or the actual broadcast server.

Applicant further notes that the present invention receives that broadcast after it has been broadcast publicly regardless of whether any other user has requested or received it. The examiner notes that this is inherent to a broadcast transmission. A broadcast is transmitted from a transmission source over open space and any user who uses a device to tune to the specific frequency will receive the broadcast. Therefore, if a user does not request or receive (tune to) the broadcast, it will not be received.

Regardless, the data is still transmitted over the broadcast network.

Applicant has further amended the claims to overcome the 112 rejection in the previous Office Action and further states that the Declaration of Professor Memon points

out where support in the specification is provided for the amended claim limitations. The examiner notes that the amendments overcome the previous 112 rejection, however the examiner notes that the amended claim limitations now simply state what is inherent to any broadcast transmission (see arguments above), which clearly reads on the Ginter reference.

Applicant further argues the cited portions of Ginter fail to teach monitoring a broadcast and **clearly not with a location where the usage is being monitored**. Regardless of the fact that this argument is in direct contradiction with Applicant's argument of the monitoring process being independent of a specific location, Ginter specifically states at Column 3, Lines 24-33 that the VDE system to, "*reliably detect and monitor the use of commercial information products*" and that VDE uses, "*VDE uses a wide variety of different delivery means: including... digital **broadcast***". Even further Ginter goes on to teach (**in the same citation**) that "*VDE can be used by major network providers, hardware manufacturers, owners of electronic information, providers of such information, and clearinghouses that gather usage information regarding, and bill for the use of, electronic information*". Therefore, since Applicant has stated that the location of where the monitoring takes place in the network, any one of the content distributors can be interpreted as a **monitoring station**.

Also note at Column 147, Lines 50-60 and the Table in Column 148, which further defines the information collected when monitoring takes place. In Column 147, Ginter teaches that records of content usage can span months, while the table in

Column 148 teaches that each record keeps track of users (be a user id) who request the content.

Further note Figure 3, which teaches that before the user is supplied the content a meter records the request/usage, therefore, clearly content is being monitored.

All of these examples above, as well as many other portions of Ginter, clearly teach that monitoring of broadcasted content takes place.

The examiner notes that since Ginter teaches that content is broadcasted and monitored, how could Ginter monitor any piece of data if the monitoring device (taught by Ginter) never receives the broadcast? If the monitoring device of Ginter never received the broadcast, there is no possible way Ginter could collect data for that broadcast.

Further, in response to Professor Memon's Declaration, Professor Memon states that Column 3, Lines 24-33 does not mention monitoring and broadcast. As quoted from Column 3, Lines 24-33 of Ginter above, both of the words "monitor" and "broadcast" are clearly stated and used in a system that reads on the claimed limitations. Professor Memon further states that Ginter only teaches monitoring at each and every recipient of the broadcast. Again this is contradictory to what has been argued above since the location of where the broadcast is monitored has been stated to be insignificant. Regardless, as stated above, *"VDE can be used by major network providers, hardware manufacturers, owners of electronic information, providers of such information, and clearinghouses that gather usage information regarding, and bill for the use of, electronic information"*. Clearly any of these locations are not each and every

recipient of the public broadcast (**regardless of this point being moot based on Applicant's own arguments**).

In regards to the remaining arguments made by Applicant and Professor Memon, see the above rebuttal. Further the examiner notes that claims still read on the rejection of record.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al. (U.S. Patent No. 6,253,193) in view of Wiser et al. (U.S. Patent No. 6,385,596).

Referring to claim 1, Ginter discloses compensating at least one rights holder responsible for content of a digital audio recording file for the public performance of the content (see Column 3, Lines 20-24 and Column 4, Lines 8-13 for the present invention employing a system to compensate a digital rights holder for content of a digital audio recording file (see Column 4, Lines 17-20) for the public performance of the content (*note that is the electronic information is broadcasted, then it is broadcasted to be consumed by a listener/viewer*)), the

content being included in a public broadcast (see Column 3, Lines 24-29 for monitoring the content distributed from a digital broadcast and note arguments above for further portions of Ginter that teach that the electronic content can be broadcasted). *Also note Column 260, Lines 11-15 for tracking "live performances", which are public performances.*

Ginter also discloses associating an identification code with the digital audio recording file to produce an identified digital audio recording file (see Column 130, Lines 7-11 for "embedded" content in a VDE object and Column 58, Lines 43-46 and Lines 59-64 for the VDE object containing a digital audio recording and further note Figure 20 for a content object containing identification information).

Ginter also discloses generating an identification record correlating to the identification code and the digital audio recording file (see Column 153, Line 32 through Column 154, Line 67 for an object registry containing a database that stores a list all of content objects that a user receives).

Ginter also discloses broadcasting the identified digital audio recording file as an encoded audio signal, in the public broadcast (see again Column 127, Lines 6-8 for "content delivery" over the media and Column 53, Lines 1-10 for broadcasting the information), wherein the public broadcast being made by one of a radio or television station broadcast (see Column 14, Lines 5-10), including cable and satellite networks and Internet websites (see Column 18, Lines 60-64).

Ginter also discloses that the public broadcast is capable of remotely receivable simultaneously by a plurality of users constituting audience members of the public

capable of receiving the audio signal being publicly broadcast (see Column 127, Lines 45-49 for sending the VDE object to an electrical appliance and again note Column 3, Lines 24-33 for a digital broadcast being the distribution method for transmitting the VDE content to the user; simply by teaching a digital broadcast network allows the system of Ginter to be capable of publicly broadcasting content to a viewer). *Also note above that television broadcasting networks can be used, which simultaneously transmit content to a plurality of audience members of a public broadcast.*

Ginter also discloses receiving by a monitoring station the audio signal being publicly broadcast and Ginter also discloses feeding by said monitoring station the audio signal into monitoring means for detecting the identification (see again Column 3, Lines 24-33, Figure 3 and Column 147, Line 36 through Column 148, Line 33 and the examiner's rebuttal to Applicant's arguments above).

Ginter also discloses storing and correlating (by said monitoring station) the identification code and data (see Column 153, Lines 53-59 for storing registration information relating to the VDE data in a secure database 610 and further note Column 147, Line 36 through Column 148, Line 33 for storing and correlating identification codes and data related to the data received) solely related to the public broadcast (see again Column 3, Lines 24-33 and the examiner's rebuttal to Applicant's arguments above) and unrelated to whether even any user constituting the audience members of the public have received the broadcast (see examiner's rebuttal to Applicant's arguments regarding this limitation) that stores and

associates the identification code, and based on said identification code records and stores the identification code (**see Column 153, Lines 62-64 for storing data from the VDE object 300**) and transmission and broadcast related data in a batch file (**see also saving shipping (*transmission*) and receiving (*broadcast*) data in tables (*batch file*) 444 and 446 in Figure 16**), said broadcast related data including a date that the encoded audio signal was monitored, a time of day that the encoded audio signal was monitored (**Column 155, Lines 22-23**), and the duration of the monitored encoded audio signal (**see Column 152, Lines 26-27 for a data length, which in the case of an audio file defines how long the song is**). *Also note that the system of Ginter discloses tracking VDE, which is the content that is broadcast, and thus inherently teaches the limitation, “unrelated to the users constituting the audience members of the public”.*

Ginter teaches compensating a user for his/her work (**see Column 3, Lines 20-24 and Column 4, Lines 8-18**), but fails to disclose decoding and importing the batch file into a first database that catalogs performance, transmission and broadcast of the encoded audio signal and using the first database to accurately compensate the at least one performance artist responsible for generating content on said digital audio recording file.

Wiser discloses a logging module 1014, which catalogs performance, transmission and broadcast of the encoded audio signal (**see Column 23, Lines 18-19 for logging each purchase of a media data file 200, which if purchased are transmitted/broadcasted (see Column 11, Lines 53-55)**). Wiser also discloses that

these logs are used to accurately compensate the at least one performance artist responsible for generating content on said digital audio recording file (**see Column 23, Lines 21-30 and Column 11, Lines 55-57 for reporting royalty payments**).

Therefore, Wiser discloses decoding and importing the batch file into a first database that catalogs public performance, based upon the incidence of the public broadcast and unrelated to the number of actual audience users and broadcast of the audio signal.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the VDE system, as taught by Ginter, using the payment and reporting tracking system, as taught by Wiser, for the purpose of allowing music industry participants to protect their copyrights and could be used by rights reporting agencies to bill distributors for royalties associated with the volume of electronic distribution of the media data files (**see Column 11, Lines 57-61 of Wiser**).

Claim 2 corresponds to claim 1, where Wiser discloses that the identification code embedded in the audio signal is a digital watermark (see Column 7, Lines 17-19).

Claim 3 corresponds to claim 1, where Ginter discloses embedding the identification code is performed by encoding software (see Column 6, Lines 45-55).

Claim 4 corresponds to claim 1, where Wiser discloses the identification code is in the form of a non-audible digital signal that is not rendered inoperable by one or more generations of analog taping and broadcast compressions (see the rejection of claim 2,

which discloses the encoding of a watermark, which is not rendered inoperable by such analog deficiencies).

Claim 5 corresponds to claim 1, where Wiser discloses a second digital work library database to match the embedded identification code with the title of a digital audio work and its associated file information, and importing said title and associated file information from the second digital work library database to the first database (see element 120 in Figure 1 and Column 12, Lines 58-60 for a second database used to store the audio file and descriptive data (see Column 6, Lines 48-65)).

Claim 6 corresponds to claim 5, where Wiser discloses using the embedded identification code to match the digital audio work's title to the recorded and stored transmission or broadcast related data (see Column 14, Lines 52-60 for searching database 120 if the audio file is not stored at content manager 112) and Ginter discloses printing a digital audio work usage report having both the title of the digital audio work and the transmission and broadcast related data (see Column 228, Lines 45-56).

Claim 7 corresponds to claim 1, where the examiner notes that multimedia includes both audio and video, therefore the digital audio recording file is multimedia.

Referring to claim 9, see the rejection of claim 1.

5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al. (U.S. Patent No. 6,253,193) in view of Wiser et al. (U.S. Patent No. 6,385,596) in further view of BMI (What is a Cue Sheet?).

Referring to claim 8, Ginter and Wiser teach the limitations of claim 1, but fail to disclose the use of a cue sheet.

BMI teaches using a cue sheet for keeping track of all the music used in films and on television shows (see Page 1, Third Paragraph for types of information in a cue sheet and Pages 2 and 3 for a sample cue sheet).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the information being tracked by Ginter and Wiser, using BMI's cue sheet, as taught by BMI, for the purpose of ensuring its writers and publishers receive the royalties due to them (see Page 1, First Paragraph of BMI).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P. Salce whose telephone number is (571) 272-7301. The examiner can normally be reached on M-F 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jason P Salce
Primary Examiner
Art Unit 2623

December 23, 2007

A handwritten signature in black ink, appearing to read "Jason Salce", is written over the typed name and title.